

Application No. 10/749,418

REMARKS

Claims 1-30 are pending. By this Amendment, claims 3, 5, 11, 13, 19, 21, 28 and 30 have been amended. No new matter is introduced by the present Amendment.

Currently, claims 1-30 stand as rejected, and Applicants respectfully request reconsideration of the rejection based on the following remarks.

In the Office Action, the Examiner objected to the declaration, asserting that the signature of Jonas Sidaravicius is distorted. Additionally, the Examiner asserted that “[a] supplemental oath or declaration for this individual is required which has a clear signature.” With all due respect, Applicants submit that the signature of Jonas Sidaravicius was not distorted during the fax transmission of the declaration, since the rest of the declaration is clear. Furthermore, there is no legal requirement that an inventor’s signature on a declaration has to be “clear.” See 37 C.F.R. § 1.63. The declaration as filed clearly identifies that Jonas Sidaravicius is an inventor, indicates his country of citizenship and is signed by Mr. Sidaravicius. As such, the declaration complies with 37 C.F.R. § 1.63, and therefore no supplemental declaration is required in this case. Accordingly, Applicants respectfully request the withdrawal of the objection to the declaration.

Rejections Under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 1-30 under 35 U.S.C. § 112, first paragraph, asserting that “the artisan would have to resort to undue experimentation to produce compounds having ‘part of a ring’ or free bond as claimed.” Applicants submit that the specification enables one of ordinary skill in the art to make and use the invention commensurate with the scope of the claims, and respectfully request reconsideration of the rejection based on the following comments.

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With respect to the term "part of a ring group", Applicants submit that one of ordinary skill in the art would understand that part of a ring group is an atom or group that is bonded to other atoms or groups in a ring system. As such, the terminology is being used to indicate that the claims include groups where, for example, two R groups are connected to form a cyclic group. For example, R₄ and R₅ can be connected to form a ring group, and in that case each R group forms part of the ring group. Additionally, based on the synthetic approaches described on pages 24-29 of the specification, one of ordinary skill in the art would be able to produce a charge transport material where, for example, R₄ and R₅ are connected by selecting appropriate precursor compounds. In other words, one of ordinary skill in the art could use the general synthetic approaches described in the specification to form charge transport compounds where two R groups form part of a ring group. Thus, the specification enables one of ordinary skill in the art to make and use the invention commensurate with the scope of the claims.

With respect to the term "a bond," Applicants submit that one of ordinary skill in the art would recognize that when any of the R groups are a bond, the bond is connected to an adjacent atom or group and is not a "free" bond. As such, Applicants submit that the term "a bond" generally is definite and is fully enable by the specification. However, to advance prosecution of the case, Applicants have removed the term "a bond" from the claims.

Since the specification enables one of ordinary skill in the art to make and use the invention commensurate with the scope of the claims, Applicants respectfully request the withdrawal of the rejection of claims 1-30 under 35 U.S.C. § 112, first paragraph.

Rejections Under 35 U.S.C. 112, Second Paragraph

In the Office Action, the Examiner rejected claims 1-30 under 35 U.S.C. § 112, second paragraph, as being indefinite. More specifically, the Examiner asserted that claims 1-30 are indefinite because the term part of a cyclic ring is an incomplete structure and "it is unclear how

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such a partial structure defines, with the other components, a charge transport compound.” Applicants submit that the term part of a ring group is definite, and respectfully request reconsideration of the rejection based on the following remarks.

“The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’” See MPEP § 2173.02 (quoting *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081, 1088 (Fed.Cir 1986)). As discussed above, one of ordinary skill in the art would understand that “part of cyclic ring”, or part of a ring group, refers to an atom or group that is bonded to other atoms or groups in a ring or cyclic system. For example, a carbon atom in a benzyl group is part of cyclic ring. Moreover, this terminology is being used to describe the situation where, for example, two R groups are connected to form a cyclic ring group. In this situation, each R group forms part of the cyclic ring group. Since one of ordinary skill in the art would understand what “part of a cyclic ring” means, the term “part of a cyclic ring” is definite.

Since the term “part of cyclic group” is definite, Applicants respectfully request the withdrawal of the rejection of claims 1-30 under 35 U.S.C. § 112, second paragraph, as being indefinite.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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